



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/734,046

12/11/2003

Sandy Garrett

GAO-001.01

8990

25181

7590

04/30/2008

FOLEY HOAG, LLP  
PATENT GROUP, WORLD TRADE CENTER WEST  
155 SEAPORT BLVD  
BOSTON, MA 02110

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

04/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,046	<b>Applicant(s)</b> GARRETT, SANDY	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 29-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-28 and 32-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-61 are pending. Claims 17-28 and 32-61 in Group II have been provisionally elected and claims 1-16 and 29-31 have been withdrawn without traverse in response to the election/restriction filed 2/04/08. Claims 17-28 and 32-61 will be examined on the merits.

#### ***Claim Objections***

Claims 18-28 and 32-61 are objected to because of the following informalities: Claims 18-28, 32-44, and 54-56 recited "A computer-readable medium as defined in ...". The preamble of these claims should recite "The computer readable medium as defined in claim ...". Claims 46-51 recite "A method as defined in claim ...". The preamble of these claims should recite "The method as defined in claim ...". Claims 45 recites "For specifying at least one of payments for and depreciation of equipment, a method comprising: ". The preamble would be better as "A method for specifying at least one of payments for depreciation of equipment, a method comprising:". Claims 52 and 57 have a similar problem with the preamble.

. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17, 22, 25, 32, 37, 38, 40, and 45-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The

claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's formulas in the claims are not found in the specification or the drawings.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-28 and 32-61 rejected under 35 U.S.C. 102(b) as being anticipated by (US 6,502,080) Eichorst et al, hereafter Eichorst.

Claim 17, Eichorst discloses, A computer readable medium as defined in claim 52 wherein: A) the quantity is the payment for equipment usage during the time period (col. 1, lines 29-35); B) the instructions direct the computer system to calculate the quantity by employing operations that include: i) multiplying by a price per unit of usage a pre-update aggregate usage and subtracting a total of previous payments, wherein cumulative payments are at least equal to an amount determined by multiplying the cumulative commitment by the price per unit of usage (col. 5, lines 21-54); and ii) updating the pre-update aggregated usage to obtain a value for the updated aggregated

usage that reflects the cumulative payments when the cumulative commitment exceeds the pre-update aggregated usage (col. 6, line 45-col. 7, line 6).

Claim 18, Eichorst discloses, A computer readable medium as defined in claim 17 wherein the instructions direct the computer system to: subtract a credit from the payments for the equipment usage for a time period when the pre-update aggregated usage is greater than the cumulative commitment and greater than cumulative actual usage through the time period (col. 4, lines 30-42); and update the pre-date aggregated usage to obtain a value for the updated aggregate usage that reflects the credit (col. 4, lines 43-57).

Claim 19, Eichorst discloses, A computer readable medium as defined in claim 18 wherein the instructions to subtract the credit further comprise instructions to: determine a first difference between the pre-update aggregate usage and the cumulative actual usage (col. 4, lines 33-42); determine a second difference between the pre-update aggregate usage and the cumulative commitment (col. 4, lines 43-57); and determine the credit by multiplying the price per unit of usage by a lesser one of the first difference and the second difference (col. 5, lines 21-54).

Claim 20, Eichorst discloses, A computer readable medium as defined in claim 17 wherein the instructions to establish a price per unit of usage further comprise instructions to establish the costs based on at least one of an acquisition cost of the equipment services to be provided, and supplies to be provided (col. 1, line 29-col. 2, line 15).

Claim 21, Eichorst discloses, A computer readable medium as defined in claim 17 wherein the instructions to establish a price per unit of usage further comprise instructions to establish the costs based on at least one of an expected value of the equipment after a predetermined number of time periods, expected remarketing costs, a time value of money, profit margins, and risk of loss (col. 2, lines 46-59).

Claim 22, Eichorst discloses, A computer readable medium as defined in claim 17 containing instructions to: identify a number of time periods as a term for the usage of the equipment (col. 1, lines 28-55); identify a total commitment for the term of usage as the cumulative commitment for the time periods of the term (col. 1, line 61-col. 2, line 9); and limit the payments obtained to the total commitment multiplied by the price per unit of usage (col. 9, lines 4-15).

Claim 23, Eichorst discloses, A computer readable medium as defined in claim 22 further containing instructions to obtain a payment to purchase the equipment when a total of payments exceeds the total commitment multiplied by the price per unit of usage (col. 9, lines 16-27).

Claim 24, Eichorst discloses, A computer readable medium as defined in claim 22 further comprising instructions to: determine a price per unit of usage based on continued usage of the equipment beyond the total equipment (col. 5, lines 31-42) and obtain payments for continued usage based on the continued usage multiplied by the price per unit of usage (col. 5, lines 43-54).

Claim 25, Eichorst discloses, A computer readable medium as defined in claim 17 wherein: A) where  $c_j$  is an incremental commitment for the time period (col. 1, lines

28-35) and B) the computer-readable medium contains instructions to set the incremental commitment for at least one time period at a start of the equipment usage to a lesser amount than the incremental commitments for other time periods (col. 1, lines 36-55).

Claim 26, Eichorst discloses, A computer readable medium as defined in claim 17 further containing instructions to: increase the minimum number of units of usage (col. 1, line 61-col. 2, line 9); and obtain upgrades for the equipment based on the increase (col. 2, lines 20-30).

Claim 27, Eichorst discloses, A computer readable medium as defined in claim 17, further comprising instructions to: remarket the equipment to obtain new equipment (col. 1, line 61-col. 2, line 20); and adjust the payments based on a difference between a market value and a value realized by the remarket (col. 1, lines 36-45).

Claim 28, Eichorst discloses, A computer readable medium as defined in claim 17, wherein the equipment comprises multiple pieces of equipment and wherein the instructions to obtain the value of actual usage direct the computer system (col. 1, lines 8-11) to combine usage for the multiple pieces of equipment (col. 3, line 21-col. 4, line 29).

Claim 32, Eichorst discloses, A computer-readable medium as defined in claim 52 wherein the quantity is the payment for equipment usage during the time period, and the instructions direct the computer system to: establish a price per unit of usage (col. 1, line 61-col. 2, line 15); determine a greater one of a pre-update aggregated usage and the cumulative (col. 1, lines 28-55); multiply the greater one by the price per unit of

usage and subtract a total of previous depreciation to obtain a depreciation expense for the time period (col. 5, lines 21-54); and update the pre-update aggregated usage to obtain an updated aggregated usage that reflects the cumulative minimum commitment when the cumulative minimum commitment is greater than the pre-update aggregated usage (col. 6, line 45-col. 7, line 6).

Claim 33, Eichorst discloses, A computer-readable medium as defined in claim 32 wherein the instructions establish a price per unit of usage comprise instructions to adjust the price per unit of usage when a predetermined threshold amount of usage is exceeded (col. 2, lines 46-59).

Claim 34, Eichorst discloses, A computer-readable medium as defined in claim 32 wherein the instructions to establish a price per unit of usage comprise instructions to: identify costs of the equipment (col. 4, lines 33-42); and determine the price per unit of usage based on the costs of the equipment (col. 4, lines 43-57).

Claim 35, Eichorst discloses, A computer-readable medium as defined in claim 34 wherein the instructions to identify costs of the equipment comprise instructions to determine the costs based on at least one of an acquisition cost of the equipment, service to be provided, and supplies to be provided (col. 3, lines 21-64).

Claim 36, Eichorst discloses, A computer-readable medium as defined in claim 35 wherein the instructions to identify costs of the equipment further comprise instructions to determine costs based on at least one of an expected value of the equipment after a predetermined number of time periods, remarketing costs, a time value of money, profit margins, and risk of loss (col. 1, line 29-col. 2, line 15).



Claim 37, Eichorst discloses, A computer-readable medium as defined in claim 32 wherein the instructions direct the computer system to: identify a number of time periods as a term for the usage of the equipment (col. 1, lines 28-55); and limit the depreciation expense to a total commitment equal to the cumulative commitment for the time periods of the term multiplied by the price per unit of usage (col. 9, lines 4-15).

Claim 39, Eichorst discloses, A computer-readable medium as defined in claim 37, further comprising instructions to: determine a price per unit of usage based on continued usage of the equipment beyond the total commitment (col. 5, lines 31-42); and incur additional depreciation expense for the continued usage based on the continued usage multiplied by the price per unit of usage (col. 5, lines 43-54).

Claim 40, Eichorst discloses, A computer-readable medium as defined in claim 32, wherein: A) where  $c_j$  is an incremental commitment for the time period (col. 1, lines 28-35) and B) the computer-readable medium contains instructions to set the incremental commitment for at least one time period at a start of the equipment usage to a lesser amount than the incremental commitment for other time periods (col. 1, lines 36-55).

Claim 41, Eichorst discloses, A computer-readable medium as defined in claim 32, further comprising instructions to: increase the cumulative commitments (col. 1, line 61-col. 2, line 9); and obtain upgrades for the equipment based on the increase (col. 2, lines 20-30).

Claim 42, Eichorst discloses, A computer-readable medium as defined in claim 32, wherein the instructions direct the computer system to: remarket the equipment to

obtain new equipment (col. 1, line 61-col. 2, line 20); and adjust the depreciation expense based on a difference between a market value and a value realized by the remarket (col. 1, lines 36-45).

Claim 43, Eichorst discloses, A computer-readable medium as defined in claim 32, wherein the instructions to incur the depreciation expense further comprise instructions to: subtract a credit from the depreciation expense for a time period when the pre-update aggregated usage is greater then the cumulative commitment through the time period, and greater than the cumulative usage through the time period (col. 4, lines 30-42); and update the pre-update aggregated usage obtain an updated aggregated usage that reflects the credit (col. 4, lines 43-57).

Claim 44, Eichorst discloses, A computer-readable medium as defined in claim 32, wherein the equipment comprises multiple pieces of equipment, the instructions further directing the computer system to: track usage per time period for each one of the multiple pieces of equipment (col. 3, lines 22-64); and combine the usages per time period for the multiple pieces of equipment to obtain the actual usage (col. 3, line 65-col. 4, line 29).

Claims 45, 52, and 57. Eichorst discloses, For specifying at least one of payments for and depreciation of equipment, a method comprising:

A) obtaining cumulative commitments  $C_j$  to usage of the equipment for successive time periods  $j = 1, 2, \dots$  (col. 1, lines 19-35); and

B) employing a computer system to, for each given,  $i$ th time period of a plurality of the time periods: i) obtain the value  $u_j$  of actual usage of the equipment (col. 1, lines

Art Unit: 3696

36-55); ii) calculate therefrom a quantity  $p_i$  based on a usage value equal to the difference  $A_i - A_{i-1}$  between an updated aggregated usage  $A_{i-1}$  for the given time period and an updated aggregated usage  $A_{i-1}$  for the previous time period, where the updated aggregated value  $A_k$  for any,  $k$ th time period is at least as great as the greater of the  $k$ th time period's cumulative commitment  $C_k$  and the  $k$ th period's cumulative  $k$  actual usage  $U_k = \sum_{j=1}^k u_j$  (col. 1, line 61-col. 2, line 15); and iii) provide an output that specifies the quantity thus calculated as at least one of the payment and the depreciation for the given time period (col. 4, line 58-col. 5, line 20).

Claims 46, 53, and 58, Eichorst discloses, A method as defined in claim 45 wherein  $A_k$  is the greater of: A) the  $k$ th time period's cumulative commitment  $C_k$  (col. 5, lines 21-30); and B) the sum of the  $k$ th time period's actual usage  $u_k$  and the previous time period's updated aggregated usage  $A_{k-1}$  (col. 5, lines 21-54).

Claims 47, 54, and 59. Eichorst discloses, A method as defined in claim 46 wherein the quantity  $p$  calculated for the given,  $i$ th time period equals the product  $r_i \cdot (A_i - A_{i-1})$  of a price  $r_i$  per unit of usage and the difference  $A_i - A_{i-1}$  between the updated aggregated usages of the given and previous time periods (col. 6, line 61-col. 7, line 6).

Claims 48 and 51. Eichorst discloses, A method as defined in claim 47 further including at least one of incurring depreciation expense in the amount of  $p_i$  and making or receiving a payment in the amount of  $p_i$  (col. 1, lines 28-35 and line 61-col. 2, line 9 and lines 20-31).

Art Unit: 3696

Claims 49 and 60. Eichorst discloses, A method as defined in claim 45 wherein  $A_{\sim}$  is the greater of the  $i$ th time period's cumulative commitment  $C$  and the  $i$ th time period's cumulative actual usage  $U_{\sim} = I$  (col. 3, line 58-col. 4, line 14).

Claims 50, 56, and 61. Eichorst discloses, A method as defined in claim 49 wherein the quantity  $p_{\sim}$  calculated for the given,  $i$ th time period equals the product  $r \cdot (A_i - A_{\sim I})$  of a price  $r$  per unit of usage and the difference  $A - A_{\sim I}$  between the updated aggregated usages of the given and previous time periods (col. 4, lines 30-57).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Whitworth (US 6,622,129) disclosed residual value risk and creating lease securitizations.

Byrne et al (US 2002/0143716) disclosed performing usage based billing.

Winch et al (US 2004/0176965) disclosed equipment availability and a usage system.

### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

April 27, 2008